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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,869	11/20/2003	William B. Pendergrass	956-282	5649
23424	7590	11/07/2005		
WALLENSTEIN WAGNER & ROCKEY, LTD				
311 SOUTH WACKER DRIVE				
53RD FLOOR				
CHICAGO, IL 60606				
			EXAMINER	
			NGO, LIEN M	
			ART UNIT	PAPER NUMBER
			3754	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/716,869

Applicant(s)

PENDERGRASS ET AL.

Examiner

LIEN TM NGO

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/8/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "24" has been used to designate both straw opening and game piece (see in the specification page 7, lines 9-19). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Strange et al. (6,056,144). Strange et al. disclose, in figs 3 and 5, a drinking cup lid comprising a raised central plateau 12 having a circumferential beveled segment (outer side of the

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plateau), a recessed well with planar annular wall, a straw opening located with the recessed well (see fig. 3), and annular trough 18 surrounding the plateau, a circumferentially spaced apart series of annular raised segments positioned within the trough (see fig. 3), and a circumferential rim 15.

4. Claims 14 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Reidinger et al. (6,311,860). Reidinger et al. disclose, in fig. 5, a drinking cup lid comprising an annular circumferential rim, a recessed well 46 having a bottom wall 44, a promotional game piece 60 affixed to the lid so as to cover the recessed well in spaced relationship to the bottom wall.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12, 13, 15-22, 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strange et al. in view of Reidinger et al..

Strange et al. does not teach a game piece having a tab located within the recessed well.

Reidinger et al. teach, in fig. 15, a game piece 60 having a tab located within a recessed well.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Strange et al. with a game piece having a tab located within the recessed well, as taught by Reidinger et al., in order to promote the selling of the product.

7. Claim 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strange et al. in view of Reidinger et al. and further in view of Johnson (5,746,312).

Strange et al. in view of Reidinger et al. does not disclose a text or indicia being in the removable covering layer.

Johnson teaches a text or indicia being in a removable covering layer.

Therefore, it would have been obvious to one having ordinary skill in the art the time the invention was made to having a text or indicia in the tab game piece which is cover the recessed well in the invention of Strange et al. in view of Reidinger et al., as taught by Johnson, in order to provide an instruction for the game piece.

8. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warden et al. (5,398,843) in view of Reidinger et al..

Warden et al. disclose, in fig. 1, a drinking lid comprising a circular raised plateau 18 having a top surface 22 and a sidewall 20 with an intended portion 20.

Warden et al. does not teach a game piece having a tab.

Reidinger et al. teach, in fig. 15, a game piece 60 having a tab extend over an intended portion of a sidewall to facilitate grasping of the tab by a user.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Strange et al. with a game piece having a tab extend over the intended portion, as taught by Reidinger et al., in order to promote the selling of the product.

### ***Response to Arguments***

9. Applicant's arguments filed 8/8/05 have been fully considered but they are not persuasive.

In regard to the drawing objection, the reference character "24" is used to designate both straw opening and game piece (see in the specification page 7, lines 9-19).

Applicant argues that Strange et al. (6,056,116) does not disclose a raised central plateau adapted to receive a promotional game piece, and the central plateau including a circumferential beveled segment over which a tab of the game piece may extend. However, that is not found convincing because Strange et al. disclose, in fig. 5, a drinking lid comprising a raised central plateau 12. It has been held that the recitation that an element "adapted to" perform a function is not a positive limitation by only requires the ability to perform. It does not constitute limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Also, Strange et al. disclose, in fig. 5, the central plateau including a circumferential beveled segment (the outer wall of the plateau 112). The statement of intended use of "over which a tab of the game piece may extend"

has been carefully considered, but deemed not to impose any structural limitations on the claims distinguish over the Strange et al. invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham 2, USPQ 2d 1647 (1987). Applicant further argues that the bevel segment (16-3) is only a portion of the sidewall (16-2), and is angled differently with respect to the rest of the side wall (16-2). However, these limitations are not required in the claims.

Applicant argues that Reidinger (6,311,860) does not disclose "a promotional game piece affixed to said lid so as to cover said recessed well in space relationship to said bottom wall thereof" in claim 14. However, that is not found convincing, because examiner considers the sealing member 60 of Reidinger, which is used to cover a game piece 54, 56, as a promotional game piece, which is affixed to said lid so as to cover said recessed well in space relationship to said bottom wall thereof as shown in fig. 5 of the Reidinger.

10. In response to applicant's argument that there is no suggestion or motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

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1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion or motivation to combine references in the 103 rejections for claims 12, 13 and 15-35 are provided in the rejections above.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIEN TM NGO whose telephone number is 571-272-4545. The examiner can normally be reached on Monday through Friday from 8:30 AM -6:00 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL MAR can be reached on 571-272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LIEN TM NGO  
Primary Examiner  
Art Unit 3754

October 19, 2005

